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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,875	01/08/2002	Itaru Honma	011786	6435
23850	7590	02/20/2004	EXAMINER	
ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP 1725 K STREET, NW SUITE 1000 WASHINGTON, DC 20006			LE, HOA VAN	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 02/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/038,875	Applicant(s) HONMA ET AL.	
	Examiner Hoa V. Le	Art Unit 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 with broadest independent claim 1 as the main invention is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>14 June 2002</u> | 6) <input type="checkbox"/> Other: ____ |

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This application is before the examiner for consideration on the merits.

I. The application has been carefully studied. There are three groups of the claims (1-14), (14-15) and (26) with broadest independent claim 1 as the main invention. They are not considered to be patentably different or distinct. Accordingly, no separate consideration and search is made. Should applicants show or urge otherwise in the next response to this Office action in order for it to be considered timely. A restriction will be made for the record as shown or urged.

II. Applicants' prior art submission filed on 14 June 2002 has been considered to the extent of the English language as provided only.

III. A. (1) It is allowed to claim by a functional, characteristic, physical and/or chemical property of a material and /or process. (2) However, a claimed functional, characteristic, physical and/or chemical property of a material and/or process carries with a risk (In re In re Schreiber, 44 USPQ2d 1432). It is reasonable that the Office is not supplied, provided or equipped with a sufficient facility to carry out a test for the functional, characteristic, physical and/or chemical properties as claimed in accordance with the authority stated in In re Best, 195 USPQ 430; Ex parte Maizel, 27 USPQ2d 1662 or Ex parte Phillip, 28 USPQ2d 1302. The language "a phase-separate structure...the continuous ion-conducting paths", "...sea-island structure..." or the like is considered as the functional and characteristic property of a material.

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(B) In *re Schreiber*, 44 USPQ2d 1429 state that "A patent applicant is free to recite features of an apparatus either structurally or functionally. See *In re Swinehart*... 169 USPQ 226, 228... Yet, choosing to define an element functionally, i.e., by what it does, carries with a risk. As our predecessor court state in *Swinehart*... where the Patent Office has reasons that the functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on." An argument alone may be given a little to no value as clearly pointed out and set forth on the record. If someone later show it, a claim would have no value.

IV. The counsel for the assignees fails to disclose to the Office that there is a very close related patent 6,680,138.

V. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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VI. Claims 1-26 with broadest independent claim 1 as the main invention are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,680,138. Although the conflicting claims are not identical, they are not patentably distinct from each other because they contain the same or substantially the same embodiments. Applicants should show or provide an evidence to the contrary.

VII. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-26 with claim 1 as the main invention are rejected under 35 U.S.C. 103(a) as being unpatentable over Takada et al (5,682,261).

Takada et al disclose, teach, suggest demonstrate and reduce to practice with a proton conducting membrane comprising a carbon containing compound and an inorganic acid. The language "a phase separate structure" or the like is a physical property of a material. At the level of one skilled in the art, it is reasonable to find that the applied material is reasonably have the same or substantially the same physical property as claimed since it is made up of about the same process and about the same chemical ingredients. Applicants are urged, requested and required to show or provide an evidence to the contrary as clearly pointed out an set forth on the record as allowed by law in form paragraph "III" above for a complete and timely consideration and examination during the prosecution of this application. Please see the whole disclosure of the applied reference, especially at Examples. Since Takada et al disclose, teach, suggest

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demonstrate and reduce to practice with the main and essential embodiments of the invention, the above claims are found to be rendered prima facie obvious by Takada et al.

VIII. Claims 1-26 with claim 1 as the main invention are rejected under 35 U.S.C. 103(a) as being unpatentable over Fenton et al (6,465,136). Kim et al US 2003/0099874 is cited to show the state of the art.

Fenton et al disclose, teach, suggest demonstrate and reduce to practice with a proton conducting membrane comprising a carbon containing compound and an inorganic acid. The language "a phase separate structure" or the like is a physical property of a material. At the level of one skilled in the art, it is reasonable to find that the applied material is reasonably have the same or substantially the same physical property as claimed since it is made up of about the same process and about the same chemical ingredients. Applicants are urged, requested and required to show or provide an evidence to the contrary as clearly pointed out and set forth on the record as allowed by law in form paragraph "III" above for a complete and timely consideration and examination during the prosecution of this application. Please see the whole disclosure of the applied reference, especially at col.6:30-60, 9:22-60 and Examples. Since Fenton et al disclose, teach, suggest demonstrate and reduce to practice with the main and essential embodiments of the invention, the above claims are found to be rendered prima facie obvious by Fenton et al.

IX. Claims 1-26 with claim 1 as the main invention are rejected under 35 U.S.C. 103(a) as being unpatentable over Chisholm et al (6,468,684).

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Chisholm et al disclose, teach, suggest demonstrate and reduce to practice with a proton conducting membrane comprising a carbon containing compound and an inorganic acid. The language "a phase separate structure" or the like is a physical property of a material. At the level of one skilled in the art, it is reasonable to find that the applied material is reasonably have the same or substantially the same physical property as claimed since it is made up of about the same process and about the same chemical ingredients. Applicants are urged, requested and required to show or provide an evidence to the contrary as clearly pointed out an set forth on the record as allowed by law in form paragraph "III" above for a complete and timely consideration and examination during the prosecution of this application. Please see the whole disclosure of the applied reference, especially at col.7:49 to 8:32, 9:6-18 and Examples 1-7, 9-11, 13-14 and 17. Since Chisholm et al disclose, teach, suggest demonstrate and reduce to practice with the main and essential embodiments of the invention, the above claims are found to be rendered prima facie obvious by Chisholm et al.

X. Claims 1-26 with claim 1 as the main invention are rejected under 35 U.S.C. 103(a) as being unpatentable over McGrath et al (6,465,136).

McGrath et al disclose, teach, suggest demonstrate and reduce to practice with a proton conducting membrane comprising a carbon containing compound and an inorganic acid. The language "a phase separate structure" or the like is a physical property of a material. At the level of one skilled in the art, it is reasonable to find that the applied material is reasonably have the same or substantially the same physical property as claimed since it is made up of about the same process and about the same chemical ingredients. Applicants are urged, requested and required to

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show or provide an evidence to the contrary as clearly pointed out and set forth on the record as allowed by law in form paragraph "III" above for a complete and timely consideration and examination during the prosecution of this application. Please see the whole disclosure of the applied reference, especially at the figures and their descriptions and Examples. Since McGrath et al disclose, teach, suggest demonstrate and reduce to practice with the main and essential embodiments of the invention, the above claims are found to be rendered prima facie obvious by McGrath et al.

XI. Fenton et al (6,638,659) has about the same teachings and suggestions as those in above applied Fenton et al (6,465,136). Kim et al US 2003/0099874 is cited to show the state of the art.

XII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:00 AM to 4:00 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark F. Huff can be reached on 571-272-1385. The fax phone numbers of the examiner is 571- 273-1332. Since there is a newly electronic filing procedure for all initial communicating papers and all responses to an Office action, the examiner fax phone number is not for use to receive any fax in response to an Office action. Applicant is requested and required to send all initial communicating papers and all response to Office action to a central paper or fax receiving center for an electronic scanning procedure.

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Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306,

(2) mail with a central mail receiving address:

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Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
17 February 2004

HOA VAN LE
PRIMARY EXAMINER

